

REMARKS

Applicant now responds to the Office communication of September 23, 2004. The Applicant gratefully acknowledges the Examiner's finding that the application is in condition for allowance with the exception of certain formal matters. The Applicant now submits a Request for Continued Examination (RCE) to allow for consideration of the documents attached to the enclosed Fourth Supplemental Information Disclosure Statement, Fifth Supplemental Disclosure Statement, and Fourth Notice of Related Litigation.

The Applicant also responds to the formal matters summarized below.

Relinquishment of the original patent

In the communication, the Office requires the receipt of the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent. The Applicant respectfully acknowledges this request as a requirement under the previous rules. However, as promulgated in 69 FR 56481 (September 21, 2004), 37 C.F.R. § 1.178(a) has been amended to delete the requirement for the physical surrender of the original letters patent. The surrender of the original patent is now considered automatic upon the grant of the reissue patent. (*See* 69 FR 56521, enclosed, highlighted and tabbed for the Examiner's convenience.) The Applicant, therefore, assumes the Office no longer requires the physical surrender of the patent.

Previous Information Disclosure Submissions

The Applicant wishes to correct the form of certain references previously submitted with Information Disclosure Statements, but which have not yet been considered. To accomplish this, the Applicant's representative contacted the Office and wishes to express gratitude to Examiner Patrick Lewis and his supervisor, James O. Wilson, for their time during multiple telephone conversations and for their willingness to consider the most expedient manner for addressing

these issues. The Applicant now submits the enclosed Information Disclosure Statements to allow consideration of references not previously considered and to submit additional references for consideration.

1) Supplemental Information Disclosure Statement filed on September 19, 2003

This IDS disclosed copending applications which might be considered related or possibly related to the instant application. A number of U.S. patent application numbers were listed on an attached PTO Form 1449 but were not considered by the Examiner. After discussing this issue, with Mr. Lewis and Mr. Wilson, the Applicant's representative realizes that two issues were at hand. First, the application numbers were listed under "U.S. Patent Documents" on PTO Form 1449, and could have been more appropriately listed under "Other Documents." Second, the Office expressed concern that by printing the application numbers (listed on PTO Form 1449) on the face of the patent, certain confidential information would be disclosed.

The Applicant's representative gratefully acknowledges Mr. Wilson's willingness to reconsider this issue in light of the fact that pending U.S. patent application numbers are readily available on the public PAIR system, via continuity and patent family searches. There is no issue with confidentiality of the existence of such pending U.S. patent applications.

Accordingly, the Applicant submits a copy of the disclosure documents filed on September 19, 2003, and a modified Supplemental Information Disclosure Statement, which includes the U.S. application numbers previously submitted but not yet noted as considered, under the "Other Documents" category on PTO Form SB/08. This Supplemental Information Disclosure Statement also includes recently filed applications, which might possibly be considered, related to the instant application.

The Applicant also encloses a Fifth Supplemental Information Disclosure Statement, which lists the Office Actions, Responses and other prosecution documents in certain co-pending applications, which claim priority to the application, which led to U.S. Patent No. 5,830,887.

2) Supplemental Information Disclosure Statement filed on January 6, 2004

In a recent telephone conversation, Examiner Lewis stated that he had no record of the Information Disclosure Statement filed on January 6, 2004. This IDS also disclosed copending applications which might be considered related or possibly related to the instant application. The Applicant submits a copy of the original papers as filed and the postcard stamped as received by the Patent and Trademark Office. The Applicant also provides these previously submitted U.S. Patent numbers and U.S. Application numbers under the "Other Documents" category on PTO Form SB/08, attached to the enclosed Supplemental Information Disclosure Statement.

3) Supplemental Information Disclosure Statement filed on March 17, 2004

According to the initialled copy of PTO Form 1449, which was returned to the Applicant, the references by Bezuidenhout and Bingham were not considered because dates were lacking. This omission has been corrected and they are relisted on the PTO Form SB/08 attached to the enclosed Supplemental IDS.

The Statutory declarations listed on pages 8 and 9 of PTO Form 1449 were not noted as considered. In a previous conversation with Examiner Lewis, he indicated that such documents are not properly listed on PTO Form 1449. Applicant respectfully requests that Examiner Lewis acknowledge their submission by listing them on an interview summary or an office communication and stating for the record that they have been considered. Applicant does not resubmit these documents at this time.

Updated Notices of Related Litigation

Applicant has submitted three Notices of Related Litigation to keep the Office apprised of the events and substantive papers filed in a litigation involving two patents issuing from continuation applications claiming priority to the patent involved in the instant reissue application. Given the on-going nature of litigation, such papers continue to be created. Applicant now encloses a Fourth Updated Notice of Related Litigation and respectfully requests the Office to consider the attached court documents.


Conclusion

Again, the Applicant's representative would like to thank Examiner Lewis and Supervisor Wilson for their willingness to address these disclosure formalities as expeditiously as possible. If any issues remain unresolved, the Examiner is invited to call the Applicant's representative at 650-849-6677.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 21, 2005

By: 
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